

Notice of Allowability

Application No.

10/723,140

Examiner

Joseph Kosack

Applicant(s)

STJERNSCHANTZ ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Response to Non-Final Rejection filed April 3, 2006.
2. ☒ The allowed claim(s) is/are 24.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 07/469,442.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Claims 24-38 are pending in the instant application.

Amendments

The amendment to the claims received on April 3, 2006 has been acknowledged and has been entered into the record.

Election/Restrictions

Claims 25-28 and 30-38 were withdrawn from further consideration by the Examiner as being drawn to a non-elected invention in the office action mailed on December 29, 2005

Previous Claim Rejections - 35 USC § 103

Claims 24 and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hess et al. (USPN 4,011,262) in view of Boeckman et al. (*J. Org. Chem.* 1986, 5489-5490) in the office action mailed on December 29, 2005. Applicant's arguments received on April 3, 2006 were found to be persuasive and the rejections of claims 24 and 29 have been withdrawn.

Previous Double Patenting Rejection

Claim 29 was rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-22 and 47-50 of USPN 5,422,368. Applicant has given authorization to the Examiner to cancel claim 29 in order to obviate the rejection. Therefore, with the cancellation of claim 29, the rejection is withdrawn.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Edward D. Robinson on April 19, 2006.

Delete claims 25-38.

Reasons for Allowance

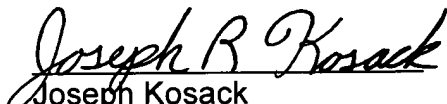
The instant application cites 13,14-dihydro-17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester. The closest art teaches the composition comprising 13,14-dihydro-17-phenyl-18,19,20-trinor-PGF_{2α}-isopropylester and an ophthalmologic compatible vehicle (USPN 5,422,368.) Since a restriction requirement was made between the compounds and compositions in the parent case, the instant compound is patentably distinct from the composition. Therefore, claim 24 is allowed. The restriction requirement made on September 30, 2005 is hereby withdrawn.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Kosack whose telephone number is (571)-272-5575. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^eKane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Joseph Kosack
Patent Examiner
Art Unit 1626


Joseph K. M^eKane
Supervisory Patent Examiner
Art Unit 1626